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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,991	08/08/2001	Rose Z. Wilde	WIL 2384.1	3602
2147	7590	05/26/2004	EXAMINER	
GRACE J FISHEL			DICUS, TAMRA	
11970 BORMAN DRIVE			ART UNIT	
SUITE 220			PAPER NUMBER	
ST. LOUIS, MO 63146			1774	

DATE MAILED: 05/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/924,991		WILDE, ROSE Z.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Tamra L. Dicus		1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**  
***Response to Amendment***

This office action is responsive to the amendment of Mar. 2, 2004.

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***Specification***

The amendment filed Mar. 2, 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: On page 1, lines 12-16, the new matter is "As the top coat dries the crackle medium contracts which causes the top coat to crack revealing glimpses of the base color through the cracks." That a crackle medium that contracts was not originally filed and is therefore considered new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention:

Claims 1 and 8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The Applicant has added that crackle medium is adapted to contract when a water-based stain or paint is applied. There is no description of crackle medium which is adapted to contract when

Art Unit: 1774

water based stain or paint is applied within the specification. The amended and new claims include new matter.

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***Claim Rejections - 35 USC § 103***

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 (amended)-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,601,876 to Oates et al. in view of USPN 4,345,044 to Columbus et al.

3. Oates teaches a water based crackle finish for a surface comprises:

(I) a base coating of stain coating on the surface, comprising:

(a) a water soluble low mol. wt. polymer; and

(II) a crackle coating (equivalent to crackle medium) applied on the base coating, comprising

(b) an aq. emulsion of a high mol. wt. polymer.

See Abstract, Figures 1-2, col. 2, lines 15-40, col. 2, line 65-col. 3, line 25. The crackle coating can be colorless or colored (col. 4, lines 5-6). Crackle coating mixture is taught at col. 5, lines 26-60. At col. 3, lines 1-10, Oates discloses the surface crackle coating is applied to a wood surface. Oates further discloses that a top coating may also be included over the crackled coating. To the new limitations to a dried base coat and a dried crackle medium, these limitations are also provided for by Oates at col. 2, lines 45-51.

Art Unit: 1774

Oates does not disclose a latex wood filler on the crackle coating as recited in instant claim 1. Oates does not teach the wood filler composition as recited in instant claim 4.

However, Columbus teaches an acrylic wood filler where the composition comprises 6-14% acrylic resin, 3-10% talc, 3-65% fillers, and 13-35% water in the abstract. Columbus also teaches applying wood filler to hard surfaces as a coating to provide excellent stain and a natural wood color in the abstract, Examples, col. 1, lines 5-15 and patented claim 1. Oates does not disclose the latex wood filler reaction when applied to crackle coating as instant claim 1. It would have been obvious to one of ordinary skill in the art to modify the crackle finish of Oates to further include the latex wood filler of Columbus because the wood filler of Columbus is used as a top coating on wood. The Columbus reference teaches coating wood filler onto surfaces as a top coating as Oates suggests.

Limitations such as "the crackle medium is tack dried before the latex wood filler is applied" (instant claim 2) and "the latex wood filler is embossed with a design before it is dried" (instant claim 3) are process limitations in a product claim. Such process limitations are not limited to the specific method steps, but only to the structure implied by the steps. For example, the structure includes crackle medium and latex wood filler, which the prior art provides. See MPEP 2113. Applicants product and the prior art are the same.

4. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,601,876 to Oates et al. in view of USPN 4,345,044 to Columbus et al. and further in view of USPN 6,217,336 to Matthews.

Oates and Columbus are relied upon above, but do not teach a kit *per se* of claims 8-10.

Matthews teaches a decorative painting apparatus and method in a kit for walls. The paint of

Matthews has included acrylic paint along with paper and other ingredients in a kit for the users convenience at col. 5, lines 40-55 and col. 6, lines 5-30. Hence, it would have been obvious to one of ordinary skill in the art to modify the crackled medium of Oates to include ingredients to be provided in a box since Matthew teaches ingredients in a kit for convenience at col. 5, lines 40-55 and col. 6, lines 5-30. Moreover, Applicant is merely using the instant invention as a kit.

### ***Response to Arguments***

1. Applicant's arguments filed 3-02-04 have been fully considered but they are not persuasive. Applicant argues as the high molecular weight polymer is applied to the water soluble base coating, the high molecular weight polymer crackles whereas when the "crackle medium" in applicant's system is applied to the base coat nothing happens. Applicant believes Oates' crackle coating (of high molecular weight polymer) and applicant's crackle medium react in entirely different manners. The Applicant has not persuasively argued. Applicant is arguing intermediate steps and actions when the final product is the same. Further, applicant appears to be arguing references individually instead of in combination as set forth above. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Oates suggests adding an additional coating. Columbus provides the missing coating of latex wood filler. When applied in combination, both references produce the same final product as applicant.
2. Applicant further argues the timing of when the latex coating is applied and when cracking has taken place. Again, the final product is claimed, which is provided for by the references.

3. Applicant argues the dried paint or stain in applicant's system is inert to the crack medium, concluding the base coat and crackle coating are different from applicant's instant invention.

Applicant has not shown this allegation to be different in any manner. Objective evidence such as comparative test results would be useful to show any difference.

4. Applicant alleges a latex wood filler is not disclosed by Columbus. This is not true.

Columbus teaches a latex wood filler. See the Abstract, Examples, col. 1, lines 5-15, and patented claim 1.

5. Applicant argues the application of wood filler to a crackle medium as the references show would not be motivated to combine because of a different purpose, such as a smooth surface.

However, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

6. Applicant alleges the crackle medium of Applicant is not a high molecular weight polymer.

However, Oates explicitly defines a crackle coating comprised of a high molecular weight polymer. Applicant claims a crackle medium, which Oates provides for. Further, that Oates teaches the composition of a crackle coating, does not necessarily exclude the ingredients, e.g. high molecular weight polymer.

Applicant argues the use of Matthews, alleging the kit has nothing to do with producing applicant's product. The Examiner does not agree. Matthew is still relied upon because Matthew teaches putting paints in a kit. Matthew was not used to teach using the crackle coating

Art Unit: 1774

ingredients as Applicant alleges. The ingredients have been provided for by Oates and Columbus.

Applicant attempts to comply with the 112 rejection by inserting new matter into the specification, e.g. a crackle medium contracts when water or stain is applied. However, this is not a way to overcome a new matter rejection. Applicant is advised to remove all new matter within the claims and specification as the matter was not originally filed.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tamra L. Dicus  
Examiner  
Art Unit 1774

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SUPERVISORY PATENT EXAMINER  
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*Cynthia H. Kelly*